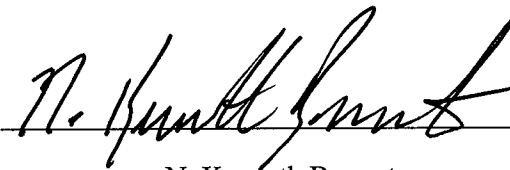


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional): <b>P114-US</b>	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO at (571) 273-8300 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <u>November 17, 2006</u> .  _____ Erin Cowles	Application Number: <b>09/527,931</b>	Filed: <b>March 17, 2000</b>	
	First Named Inventor: <b>Mathieu et al.</b>		
	Art Unit: <b>3729</b>	Examiner: <b>Rick K. Chang</b>	
<p>Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.  <small>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.            (Form PTO/SB/96)</small></p> <p><input checked="" type="checkbox"/> attorney or agent of record.            Registration number: <u>39,923</u></p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34.            Registration number if acting under 37 CFR 1.34: <u>39,923</u></p> </div> <div style="width: 50%; text-align: center;">   <u>N. Kenneth Burraston</u>            Typed or printed name   <u>(801) 323-5934</u>            Telephone number   <u>November 17, 2006</u>            Date         </div> </div> <p><small>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</small></p>			
<input checked="" type="checkbox"/> *Total of <u>3</u> page(s) of supporting argument are submitted.			

## **ARGUMENTS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In support of Applicants' Pre-Appeal Brief Request For Review of the final rejection in the Office Action dated July 21, 2006 (hereinafter the "Office Action") in the above-identified patent application, Applicants respectfully submit the following:

### **I. Background:**

Claims 71-75, 77-88, and 102-110 are pending in the application, and the current version of those claims is set forth in the Amendment dated May 1, 2006 (hereinafter the "Amendment"). Of the foregoing, claim 1 is independent. All of the claims pending in the application stand rejected under 35 USC § 102 as being anticipated by U.S. Patent No. 3,634,807 to Muenchen et al ("Muenchen").

Generally speaking, the pending claims are directed to a "method of planarizing probes, wherein said probes are disposed to correspond to terminals of one or more devices to be tested and said probes are disposed on a plurality of substrates." Although the claims are not so limited, the method of the pending claims can be advantageously used to adjust an orientation or planarity of the probes to correspond to an orientation or planarity of the terminals of the devices the probes are to contact. Thus, prior to bringing the probes and the terminals of the devices to be tested into contact, the orientation or planarity of the probes can be adjusted to correspond to the expected orientation or planarity of the terminals.

### **II. Argument:**

In the Office Action, the Examiner repeats his previous rejections of Applicants' entire claim set based on alleged anticipation by one reference, Muenchen. In particular, the Examiner argues that "it is inherent" that flexible sheet 8 [see Figures 2 and 3] can be held down in the middle "with one of the index fingers [of one of ordinary skill in the art]" while the flexible sheet 8 is on unit 1 or board 3. (Office Action, p. 3, par. 1.) He further argues that a second index finger can then be used to "adjust the shape" of the flexible sheet 8. (*Id.*) In essence, the Examiner argues that a person can use his fingers to accomplish Applicants' claimed method of planarizing probes disposed on a plurality of substrates. Applicants respectfully traverse the rejection on two grounds.

First, the index finger manipulation of Muenchen's device proposed by the Examiner is neither taught nor inherent in Muenchen. Nowhere does Muenchen teach or suggest that a user use his or her fingers to manipulate the device in the way proposed by the Examiner. Moreover, the MPEP states that "[u]nder the principles of inherency, if a prior art device, in its **normal and usual operation**, would **necessarily perform the method claimed**, *then* the method claimed will be considered to be anticipated by the prior art device." (MPEP 2112.02, emphasis added.) The index finger argument proposed by the Examiner hardly qualifies as one that "necessarily" coincides with "normal and usual operation" of Muenchen's device. Indeed, as can be seen in Figure 2 and 3, there is insufficient space between unit 1 and sheet 8 or between structure 3 and sheet 8 for a user's fingers. The Examiner's index finger theory is akin to a hindsight reconstruction of Applicants' claims because the only possible motivation for even proposing that a person of ordinary skill use his or her fingers to manipulate Muenchen's device as proposed by the Examiner is to reconstruct Muenchen in order to reject Applicants' claims. The Examiner's index finger theory thus fails to qualify as a proper inherency argument and should be disregarded. For this reason alone, the rejection of claim 1 should be withdrawn.

Second, even if a person were to use his or her fingers to manipulate Muenchen's device as proposed by the Examiner (which, as discussed above, Applicants assert is not inherent in or taught or suggested by Muenchen), the recitations in independent claim 1 would not be met. It is axiomatic that, in order to anticipate a claim, a prior art reference must teach each and every element recited in that claim. (MPEP 2131.) Manipulation of sheet 8 by a user's fingers as proposed by the Examiner would not meet the recitation in claim 71 of adjusting the first substrate *to conform a planarity of probes on the first substrate to a planarity of terminals on a device or devices to be tested without contacting the device or devices to be tested*. Note that, in claim 71, the "adjusting a shape of a surface of a first of said substrates . . ." is a substep in the step of "adjusting a planarity of contact portions of said probes to correspond to a planarity of said terminals." Therefore, claim 71 recites adjusting the first substrate *to conform a planarity of probes on the first substrate to a planarity of terminals on a device or devices to be tested without contacting the device or devices to be tested*.

Whether Muenchen's flexible sheet 8 is pressed by unit 1 and fastening element 4, by a user's fingers, or by any other means, the only possible way that a planarity of the contact elements 7 of the flexible sheet 8 (which the Examiner equated with the first substrate of claim

1) can conform to a planarity of the contacts 6 on the wiring board 3 is if the sheet 8 is pressed against the wiring board 3. Similarly, the only possible way that a planarity of the contact elements 7 of the flexible sheet 8 can conform to a planarity of the contacts 5 on unit 1 is if the sheet 8 is pressed against unit 1. (The Examiner stated that either the wiring board 3 or unit 1 can be equated with the device to be tested in claim 71.) In fact, the only way that the contact elements 7 of Muenchen's flexible sheet 8 can conform to any other device is by being pressed against the other device. There is thus simply no way that Muenchen can meet the recitation in claim 71 of adjusting the first substrate *to conform to a planarity of probes on the first substrate a planarity of terminals on a device or devices to be tested without contacting the device or devices to be tested.* In other words, Muenchen cannot meet the step of "adjusting a planarity of contact portions of said probes to correspond to a planarity of said terminals," which comprises "adjusting a shape of a surface of a first of said substrates *without contacting said one or more devices to be tested.*" For this additional reason, Muenchen does not anticipate claim 71.

Claims 72-75, 77-88, and 102-110 depend from claim 71 and are therefore patentable over Muenchen at least because of their dependency from claim 71.

### III. Conclusion:

For the reasons discussed herein, Muenchen does not anticipate independent claim 1. Applicants therefore respectfully request that the § 102 rejection of claim 1 and the dependent claims be withdrawn and all claims be allowed.